

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KARL L. HUSSMAN

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Appeal No. 1999-2030  
Application No. 08/423,077

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HEARD: May 4, 2000

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Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates generally to preoperative tissue localization apparatus (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art of record relied upon by the examiner in rejecting the appealed claims are:

Kolff	5,370,640	Dec. 6,
1994		
		(filed July 1, 1993)

The prior art as described in pages 1-3 of the appellant's specification (Admitted Prior Art).

Claims 1 to 3, 5 to 8, 10 to 13 and 15 to 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kolff.

Claims 4, 9 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kolff.

Claims 21 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kolff in view of Admitted Prior Art.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 15, mailed February 1, 1999) for the examiner's complete reasoning in support of the rejections, and to the substitute brief (Paper No. 14, filed September 21, 1998) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The anticipation rejection**

We will not sustain the rejection of claims 1 to 3, 5 to 8, 10 to 13 and 15 to 20 under 35 U.S.C. § 102(e).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Independent claim 1 is directed to an optical localization fiber comprising, inter alia, an optical fiber for connecting to a light source; and means for retaining the tip of the optical fiber proximate to a chosen location within tissue. Claims 2, 3, 5 to 8, 10 to 13, 15 and 16 depend from claim 1. Independent claim 17 is directed to an optical fiber

localization system comprising, inter alia, a light source; an optical fiber having a tip; a connector for connecting the optical fiber to the light source; and means for retaining the tip of the optical fiber within tissue. Claims 18 to 20 depend from claim 17.

The examiner determined (answer, p. 3) that independent claims 1 and 17 are "clearly anticipated by Kolff." In response to the appellant's argument, the examiner states (answer, p. 4) that Kolff teaches an optical fiber which is inserted in a catheter which includes a balloon which can be considered a retaining means.

The appellant argues (substitute brief, pp. 10-16) that Kolff does not teach the claimed retaining means. We agree. In that regard, we note that the claimed retaining means is expressed in means-plus-function format. As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the PTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Per Donaldson, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. Thus, in order to meet a "means-plus-function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989).

In this case, the corresponding structure described in the specification for performing the claimed function of the "means for retaining" are the various hooks (28, 54, 62, 72, 84, 92, 109, 114, 128) shown in Figures 1-10 and the helix (162) shown in Figure 14. Clearly, Kolff's balloon 46 on catheter 40 does not correspond to the structure disclosed by the appellant.

While there is no litmus test for an "equivalent" that can be applied with absolute certainty and predictability, there are several indicia that are sufficient to support a conclusion that one element is or is not an "equivalent" of a different element in the context of 35 U.S.C. § 112, sixth paragraph. Among the indicia that will support a conclusion that one element is or is not an equivalent of another are:

(A) Whether the prior art element(s) performs the function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element(s) disclosed in the specification. Odetics Inc. v. Storage Tech. Corp., 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir. 1999);

(B) Whether a person of ordinary skill in the art would have recognized the interchangeability of the element(s) shown in the prior art for the corresponding element(s) disclosed in the specification. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999); Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc., 145 F.3d 1303, 1309, 46 USPQ2d 1752, 1757 (Fed. Cir. 1998);

(C) Whether the prior art element(s) is a structural equivalent of the corresponding element(s) disclosed in the specification. In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990);

(D) Whether there are insubstantial differences between the prior art element(s) and the corresponding element(s) disclosed in the specification. IMS Technology, Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1436, 54 USPQ2d 1129, 1138-39 (Fed. Cir. 2000); Valmont Indus., Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1043, 25 USPQ2d 1451, 1455 (Fed. Cir. 1993).

From our review of the record in the application, the examiner never specifically found that the structure of Kolff (e.g., the balloon 46) corresponding to the recited means (i.e., "means for retaining . . .") was equivalent to the structure disclosed by the appellant (i.e., the various hooks shown in Figures 1-10 and the helix shown in Figure 14). Moreover, the examiner never applied any of the above-noted indicia to support a conclusion that the structure of Kolff (e.g., the balloon 46) is or is not an "equivalent" of the structure disclosed by the appellant in the context of 35 U.S.C. § 112, sixth paragraph. Thus, it is our view that the examiner has not met the burden of establishing a case of anticipation since the examiner has not established the structure of Kolff (e.g., the balloon 46) is an "equivalent" of the structure disclosed by the appellant.

In any event, in applying the above-noted tests for determining equivalence under the sixth paragraph of 35 U.S.C. § 112 to ascertain whether the structure of Kolff (e.g., the balloon 46) is or is not an "equivalent" of the structure disclosed by the appellant, we conclude that the structure of

Kolff is not an "equivalent" of the structure disclosed by the appellant. In that regard, it is clear to us that the structure of Kolff does not perform the function specified in the claim in substantially the same way, and does not produce substantially the same result as the corresponding element disclosed by the appellant. Furthermore, it is our view that a person of ordinary skill in the art would not have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the appellant's specification. Based upon the above determinations, we conclude that there are substantial differences between the structure of Kolff and the structure disclosed by the appellant. Accordingly, under the above-noted tests for determining equivalence under the sixth paragraph of 35 U.S.C. § 112 we conclude that the structure of Kolff is not equivalent to the structure disclosed by the appellant.

For the reasons stated above, the decision of the examiner to reject independent claims 1 and 17, and claims 2,

3, 5 to 8, 10 to 13, 15, 16 and 18 to 20 dependent thereon,  
under 35 U.S.C. § 102(e) is reversed.

**The obviousness rejection of claims 4, 9 and 14**

We will not sustain the rejection of claims 4, 9 and 14  
under 35 U.S.C. § 103 as being unpatentable over Kolff.

In the answer (p. 3), the examiner determined the added  
subject matter recited in dependent claims 4, 9 and 14 would  
have been obvious at the time the invention was made to a  
person having ordinary skill in the art. However, for the  
reasons set forth above with respect to parent claim 1, the  
claimed "means for retaining" is not taught by Kolff. Thus,  
the examiner has not established that the claimed subject  
matter as a whole would have been obvious at the time the  
invention was made to a person having ordinary skill in the  
art. Accordingly, the decision of the examiner to reject  
claims 4, 9 and 14 under 35 U.S.C. § 103 is reversed.

**The obviousness rejection of claims 21 and 22**

We will not sustain the rejection of claims 21 and 22 under 35 U.S.C. § 103 as being unpatentable over Kolff in view of Admitted Prior Art.

Independent claim 21 is directed to a method for preoperative localization of a lesion in tissue within a body part comprising, inter alia, the steps of (1) providing an optical fiber having a fiber tip; (2) providing retention means to retain the optical fiber within the body part; (3) imaging the lesion within the body part; (4) providing a medical instrument having an instrument tip; (5) positioning the instrument tip proximate to the lesion; (6) inserting the optical fiber and the retention means through the medical instrument to position the fiber tip proximate to the lesion; (7) withdrawing the medical instrument allowing the retention means to retain the fiber tip within the body part; (8) providing a light source; (9) attaching the optical fiber to the light source causing a light at the fiber tip; and (10) viewing the light radiating through the body part from the

fiber tip to determine the approximate location of the lesion.  
Claim 22 depends from claim 21.

In the answer (pp. 3-4), the examiner determined that it would have been obvious to the artisan of ordinary skill to employ an illuminated instrument such as the fiber optical stylet of Kolff in the prior art method (i.e., hookwire localization). The appellant argues (substitute brief, pp. 19-20) that the method set forth in claim 21 is not suggested by the applied prior art. We agree with the appellant.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the applied

prior art contains none. Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id.

For the reasons set forth above, the decision of the examiner to reject claims 21 and 22 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 5 to 8, 10 to 13 and 15 to 20 under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject claims 4, 9, 14, 21 and 22 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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